

REMARKS

Claims 1-31 are pending in the present application. The Office Action currently:

Rejects claims 1-10,14, 17-20, 23, 25, and 27-31 under 35 U.S.C. § 102(a);

and

Rejects claims 11-13, 15, 16, 21-22, 24, and 26 under 35 U.S.C. § 103(a).

Claims 1-6, 9, 10, 12 and 14-16 have been amended above to remove the unnecessary word “step or unnecessary phrase “the step(s) of.” Applicant respectfully submits that the remarks below traverse the above rejections and respectfully requests that the rejections be withdrawn.

I. Rejections Based Upon 35 U.S.C. § 102(a)

The current Office Action rejects independent claim 1 as being anticipated by Wei et al. (SIGGRAPH 2000 Conference Proceedings p. 479-488) (hereinafter *Wei*). But in order to anticipate claim 1, *Wei* must teach every element of the claim 1, *see* M.P.E.P. § 2131, and the Applicant respectfully submits that *Wei* fails to do so.

Claim 1 recites, among other limitations, “providing values to said matrix, wherein said values comprise random values and wherein at least a portion of said values represents a desired structure according to which graphical features of a synthesized texture are to substantially conform” (emphasis added). As Applicant fully discusses in the present application, *Wei* does not teach this aspect of claim 1. *See e.g.*, Paragraphs 0027-0033 of the present application. As the present application further explains, the technique of claim 1 is significant improvement over the teachings of *Wei* because the arrangement of graphical features found in the sample texture are maintained. Because *Wei* fails to disclose at least this aspect of claim 1, it does not anticipate claim 1. Applicant therefore respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2-10 and 14 each depend either directly or indirectly from claim 1, and thus inherit all the limitations of claim 1. Accordingly, *Wei* does not anticipate claims 2-10 and 14 for the above reasons. Therefore, Applicant respectfully requests that the Examiner withdraw the anticipation rejections of claims 2-10 and 14.

The current Office Action states that independent claim 17 is anticipated by *Wei*. However, Applicant respectfully submits that *Wei* fails to teach every element of claim 17. For instance, claim 17 recites “a second data structure defining a texture of a second plurality of values, wherein at least a portion of said values of said second data structure are random and wherein at least a portion of said values of said second data structure represent a desired structure according to which graphical features are to substantially conform” (emphasis added). As Applicant fully discusses in the present application (See e.g., paragraphs 0027-0033), *Wei* does not teach this element of claim 17. As the specification further explains, the system of claim 17 is a significant improvement over the teachings of *Wei* because the arrangement of graphical features found in the sample texture are maintained. Because *Wei* fails to disclose every element of claim 17, it fails to anticipate claim 17. Applicant therefore respectfully requests that the anticipation rejection of claim 17 be withdrawn.

Claims 18-20, 23, and 25 each depend either directly or indirectly from claim 17, and thus inherit all the limitations of claim 17. Accordingly, *Wei* does not anticipate claims 18-20, 23, and 25. Therefore, Applicant respectfully requests that the Examiner withdraw the rejections of claims 18-20, 23, and 25.

The current Office Action rejects independent claim 27 as being anticipated by *Wei*. However, Applicant respectfully submits that *Wei* fails to teach every element of claim 27. For instance, claim 27 recites “code for initializing said matrix with a plurality of values, wherein at least a portion of said values are random and wherein at least a portion of said values represent a desired structure according to which graphical features are to be arranged” (emphasis added). As Applicant fully discusses in the present application (See e.g., paragraphs 0027-0033), *Wei* does not disclose this element. Because *Wei* fails to disclose every aspect of claim 27, it does not anticipate claim 27. Applicant therefore respectfully requests that the rejection of claim 27 be withdrawn.

Claims 28-31 each depend either directly or indirectly from claim 27, and thus inherit all the limitations of claim 27. Accordingly, *Wei* does not anticipate claims 28-31. Therefore, Applicant respectfully requests that the rejections of claims 28-31 be withdrawn.

II. Rejections Based Upon 35 U.S.C. § 103(a)

Claims 11, 12, 21 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Wei*. Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Wei* in view of Gossett, U.S. Pat. No. 6,232,981 (hereinafter *Gossett*). Claims 15, 16, 24 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Wei* in view of Kent, U.S. Pat. No. 4,601,055 (hereinafter *Kent*).

A Prima Facie case of obviousness has not been established.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the second criteria, Applicant respectfully asserts that the obviousness rejections do not satisfy the first and/or third criteria.

The recited combination does not teach or suggest all claimed limitations.

The current Office Action rejects dependent claims 11, 12, 21, and 22 as obvious over *Wei*. However, to establish a *prima facie* case for obviousness, *Wei* must teach or suggest all the limitations of the rejected claims. See M.P.E.P. § 2143. Claims 11, 12, 21, and 22 are dependent from claims 1 and 17 respectively, and thus inherit all the limitations of their respective base claims. As demonstrated above, *Wei* neither teaches nor suggests all the limitations of claims 1 and 17, thus *Wei* neither teaches nor suggests all the limitations of claims 11, 12, 21, and 22. Specifically, *Wei* fails to teach or suggest the claim 1 limitations of “providing values to said matrix, wherein said values comprise random values and wherein at least a portion of said values represents a desired structure according to which graphical features of a synthesized texture are to substantially conform” (emphasis added). Also, *Wei* fails to teach or suggest the claim 17 limitations of “a second data structure defining a texture of a second plurality of values, wherein at least a portion of said values of said second data structure are random and wherein “at least a portion of said values of said second data structure represent a desired structure according to which graphical features are to substantially conform” (emphasis added). Contrarily, *Wei* indicates that each pixel of the new matrix is determined by comparing its “neighborhood” to all neighborhoods in the

original matrix. Thus, as pointed out in paragraph 0027 of the present application the algorithm of *Wei* fails to maintain graphical features arranged in accordance with a desired structure, thereby teaching away from the recited elements of claims 1 and 17. Applicant therefore respectfully requests that the 35 U.S.C. § 103(a) of claims 11, 12, 21, and 22 be withdrawn.

The current Office Action rejects dependent claim 13 as being obvious over the combination of *Wei* and *Gossett*, and dependent claims 15 and 16 as being obvious over the combination of *Wei* and *Kent*. However, to establish a *prima facie* case for obviousness, the applied combinations must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Claims 13, 15, and 16 each depend from claim 1 and thus inherit all the limitations of claim 1. As demonstrated above, *Wei* neither teaches nor suggests “providing values to said matrix, wherein said values comprise random values and wherein at least a portion of said values represents a desired structure according to which graphical features of a synthesized texture are to substantially conform” (emphasis added), as required by claim 1. As noted above, *Wei* fails to suggest this limitation and contrarily indicates that each pixel of the new matrix is determined by comparing its “neighborhood” to all neighborhoods in the original matrix. Thus, as pointed out in paragraph 0027 of the present application the algorithm of *Wei* fails to maintain graphical features arranged in accordance with a desired structure, thereby teaching away from the recited elements of claim 1. Neither *Gossett* nor *Kent* appear to disclose the above recited limitation either, and indeed, the Examiner does not rely on them to do so. Therefore, the applied combinations do not teach or suggest all the limitations of claims 13, 15, and 16. Applicant therefore respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 13, 15, and 16.

The current Office Action rejects claims 24 and 26 as being obvious over the combination of *Wei* and *Kent*. However, to establish a *prima facie* case for obviousness, the combination of *Wei* and *Kent* must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Claims 24 and 26 each depend from claim 17 and thus inherit all the limitations of claim 17. As demonstrated above for claim 17, *Wei* neither teaches nor suggests “a second data structure defining a texture of a second plurality of values, wherein at least a portion of said values of said second data structure are random and wherein “at least a portion of said values of said second data structure represent a desired structure according to which graphical

features are to substantially conform” (emphasis added). As noted above, *Wei* fails to suggest this limitation and contrarily indicates that each pixel of the new matrix is determined by comparing its “neighborhood” to all neighborhoods in the original matrix. Thus, as pointed out in paragraph 0027 of the present application the algorithm of *Wei* fails to maintain graphical features arranged in accordance with a desired structure, thereby teaching away from the recited elements of claim 17. *Kent* does not appear to disclose the above recited limitation either, and indeed, the Examiner does not rely on *Kent* to do so. Thus the combination of *Wei* and *Kent* does not teach or suggest all the limitations of claims 24 and 26. Applicant therefore respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejections of claims 24 and 26.

The Office Action does not provide the requisite motivation.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a prima facie case of obviousness, M.P.E.P. §2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01.

The Office Action in addressing claims 11, 12, 21 and 22 takes Official Notice that Parametric Texture Mapping “is a notoriously well known class of texture map,” stating as motivation:

“...it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the method to parametric texture map in order to synthesize parametric texture.”

The language of the recited motivation is circular in nature, stating that it is obvious to make the modification because it is obvious to achieve the result by stating “it would have been obvious...to extend the method to parametric texture ... to synthesize parametric texture.” Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. As noted above, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Thus, the motivation provided by the Examiner to make the modification to *Wei* to reach claims 11, 12, 21 and 22 is improper, as the motivation must establish the desirability for making the modification.

In addressing claim 13, the Office Action admits that *Wei* does not teach a sample texture that comprises “a texture of a format selected from the group consisting of red-green-blue (RGB), red-green-blue-alpha (RGBA), color index, luminance, and luminance alpha.” The Office Action attempts to cure this deficiency by introducing *Gossett*, which the Office Action alleges to teach having such a texture. The motivation for making the combination was presented as follows:

“Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of *Gossett* into *Wei* because *Gossett* discloses a method of synthesizing image and *Gossett* the texture format can be in said format in order to accurately describe texture.”

Such language is merely a statement that the reference can be modified. The statement “because *Gossett* discloses a method of synthesizing image and *Gossett* the texture format can be in said format in order to accurately describe texture” is unparsable and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Thus, the motivation provided by the Examiner to combine *Wei* and *Gossett* to reach claim 13 is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of and common knowledge is desirable.

In addressing claim 15, the Office Action admits that *Wei* does not teach resizing synthesized texture. In addressing claims 16 and 24, the Office Action admits that *Wei* does not teach a desired size is not a power of 2 and resizing synthesized texture to a size that is a power of 2. In addressing claim 26, the Office Action admits that *Wei* does not teach resizing synthesized texture. The Office Action attempts to cure these deficiencies by introducing *Kent*, which the Office Action alleges teaches these elements. The motivation for making the combination was presented as follows:

“Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of *Kent* into *Wei* because *Wei* discloses a method of synthesizing image and *Kent* discloses the synthesized image can be re-sized in order to achieve maximum contrast with the background.”

Such language is merely a statement of aspects of each of the references "*Wei* discloses a method of synthesizing image" and "*Kent* discloses the synthesized image can be re-sized." This statement fails to state any desirability for combining the references. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of *Wei* and *Kent* is desirable.

Thus, for at least the reasons advanced above the various motives provided by the Examiner for making the various combinations to reach claims 11-13, 15, 16, 21-22, 24, and 26 are improper. Therefore, the rejections of claims 11-13, 15, 16, 21-22, 24, and 26 should be withdrawn.

III. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10015867-1 from which the undersigned is authorized to draw. If the below named attorney may be of any assistance in advancing prosecution of this application, the Examiner is encouraged to call him at the phone number listed below.

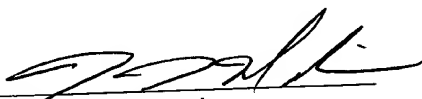
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 256037072US, in an envelope addressed to: MS Non-Fee Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: December 24, 2003

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